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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/535,495 | 07/19/2005 | Yoshiaki Yamamoto | 1417-508 | 1626 |
| 23117 7590 01/13/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | | |
| EXAMINER | | | | |
| OLADAPO, TAIWO | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
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| 01/13/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,495

Applicant(s)

YAMAMOTO, YOSHIKI

Examiner

TAIWO OLADAPO

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/07/2009 has been entered.
2. The amendment dated 10/07/2009 has been considered and entered for the record. The amendment does not overcome rejections over claims 1 – 7 which are hereby maintained. Newly added claim is rejected below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 2, 4 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiddick et al. (US 5, 173,204) in view of Ikejima et al. (2002/0072477) in view of Reidmeyer (US 6,291,407) and further in view of Okinawa et al. (US 6,444,621)
6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiddick et al. (US 5, 173,204) in view of Ikejima et al. (2002/0072477) in view of Reidmeyer (US 6,291,407) and further in view of Hasegawa et al. (US 5,854,183)
7. The rejection dated 06/25/2008 is hereby incorporated by reference, herein. The rejections are listed in §4 – 13.
8. Claims 1, 2, 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy (US 2003/0013615) in view of Kurahashi et al. (US 5,437,802)
9. In regards to claims 1, 2, 6 – 8, Levy teaches a metal working lubricant composition comprising a superabsorbent polymer and a lubricant such as a solid lubricant (abstract). The lubricant and polymer can be up to about 4 component mixture and can comprise solid lubricants such as polytetrafluoroethylene (PTFE) and hydrocarbon wax [0090 – 0092] and is present at from 0.001 up to about 99 wt % of the composition which overlaps the claimed range. Levy does not teach that the composition comprises melamine cyanurate.

Kurahashi is added to hot-rolling lubricant which is a metal working lubricant similar to Levy (abstract). Kurahashi teaches that the composition comprises solid lubricants such as PTFE and melaminecyanuric acid adduct (MCA) which are present at from 0 up to 40% which overlaps the claimed range (column 4 lines 39 – 58). Since the solid lubricants of the

composition overlap the ranges claimed, the composition would possess overlapping coefficient of friction as in claim 8.

It would have been obvious for one of ordinary skill in the art at the time of the invention to have added the solid lubricant of Kurahashi into the composition of Levy, as Kurahashi teaches solid lubricants suitable for use in metal working.

Response to Arguments

10. Applicant's arguments have been fully considered but they are not persuasive. Mr. Yoshiaki Yamamoto's Declaration under 37 C.F.R. 1.132 dated 11/18/2009 has been considered but has not been found to be persuasive to overcome the case of obviousness. The Declaration concludes that the friction coefficient of the lubricant of Chiddick is much greater than 0.100; however, the claims rejected over Chiddick do not comprise any limitations based on coefficient of friction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797